



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,045	02/04/2004	Leif O. Erickson	56165US011	3924
32692	7590	11/24/2004		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
			EXAMINER RAYFORD, SANDRA M	
			ART UNIT 1772	PAPER NUMBER

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,045

Applicant(s)

ERICKSON ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims

1. Pursuant to entry of the amendment in the 29 September 2004 response ("the last response"), claims 1-5 are pending Claim 5 is new.

Rejection Withdrawn

2. The 35 USC 102 rejection of claims 1, 3, and 4 as anticipated by Sundet (US 5,665,446) is withdrawn in view of the amendment to claim 1 in the last response.

Rejections Maintained

3. The 35 USC 103 rejection of claim 2 as obvious over Sundet is maintained for reasons of record.
4. The 35 USC 103 rejection of claim 3 as obvious over Sundet with Futhey is maintained for reasons of record.

New Objection/Rejections

Claim Objections

5. Claim 5 is objected to because of the following informalities: the term "angle", in line 6, should be --angles--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner has been unable to find support in the original specification for the new language in claim 1.

Please cancel this language or recited where support can be found for it.

8. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner has been unable to find support in the original specification for the language in claim 5.

Please cancel this language or recited where support can be found for it.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as obvious over Sundet.

Sundet is discussed in section 5 of the 02 July 2004 office action ("the last office action"). It fails to teach the new limitations recited in lines 5-7 of claim 1.

Parallel edges, opposite end surfaces on the film and major surfaces between the edges and ends are deemed conventional features in laminates such as those of Sundet. They are matters of design choice.

Response to Arguments

11. Applicant's arguments filed in the last response have been fully considered but they are not persuasive. They will be responded to in the order in which they were presented.

On page 6, applicants argue that the 35 USC 102 rejection of claims 1, 3 and 4 is improper.

However, those arguments are moot because that rejection has been withdrawn.

On page 7, applicant argues that claim 2 is not obvious over Sundet because the end surfaces limitation of claim 2 and the parallel sides and closely spaced ends of claim 2 are not taught by Sundet.

However, as the examiner stated in section 7 of the last office action, it would be matter of design choice to provide lengths with ends spaced as recited in claim 2. Applicant has not presented objective evidence to rebut this statement.

On page 7, applicant argues that there is no computer operated tape applicator used in the films suggested by Sundet and Futhey.

However, this is a process limitation that is given no weight here. See page 2, section 2 of the last office action.

On pages 7-8, applicants argue that new claim 5's limitations are not recited in the prior art.

However, the limitations are deemed matter of design choice unless convincing objective evidence that they produced unexpected results is made of record.

Final Rejection

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1772

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

S.M. Nolan - Rayford
S. M. Nolan - *RAYFORD*
Primary Examiner
Technology Center 1700

10772045(20041122)